35 U.S.C. § 101 Rejections

In the August 19, 2009 Office Action, the Examiner rejected pending claims 23 through 28 for non-statutory subject matter. The Assignee notes that claim rejections are arbitrary and capricious, based on an incorrect conclusory statements and that they are moot because claim amendments are believed to have obviated these rejections.

35 U.S.C. § 103 Rejections

In the August 19, 2009 Office Action, the Examiner rejected pending claims 1 through 19 and 23 through 28 on the basis of given Published Patent Application 2003/0208427 (hereinafter, Peters) in view of Published Patent Application 2001/0039525 (hereinafter, Messmer). Messmer matured into U.S. Patent 7,028,005. The Assignee notes that claim rejections are arbitrary and capricious, based on incorrect conclusory statements and that they are moot because claim amendments are believed to have obviated these rejections. Furthermore, the cited references do not teach or suggest a single aspect of the claimed invention.

Copending applications

Under the provisions of MPEP § 2001.06(b), the Examiner is hereby advised of information obtained from co-pending U.S. Patent Application(s) which may be "material to patentability" of the instant application (see Armour & Co. v. Swift & Co., 466 F.2d 767, 779, 175 USPQ 70, 79 7th Cir. 1972).

A review of co-pending applications has revealed that the apparently routine allowance and issue of patents to large companies for "inventions" that do not appear to meet the requirements for allowance (i.e. novelty, written description, etc.) appears to be having a material, negative impact on the prosecution of the assignee's patent applications. In accordance with the prevailing statutes, the allowance and issue of patents to large companies for inventions that do not appear to meet the requirements for allowance should not have any impact on the prosecution of Asset Trust patent applications. In fact, the U.S.P.T.O. has a professed commitment and a legal obligation to invalidate patents that do not meet the legal requirements for patentability. Unfortunately, the U.S.P.T.O. appears to be shielding the patents issued to large companies for "inventions" that do not appear to meet the statutory requirements for allowance instead of honoring their statutory obligation to invalidate them. In particular, the Assignee has recently determined that the primary reasons it has been forced to file over twenty appeals all appear to be related to efforts to bolster patents issued to large companies for inventions that do not appear to be novel. These reasons include:

1) the need to traverse apparent misrepresentations that prior art that should properly be used to prevent the allowance of (or invalidate) one or more patents issued to a large company is relevant to an Asset Trust patent application. This is the single largest reason the Assignee has been forced to file appeals.

For example, U.S. Patent 5,812,988 (hereinafter, Sandretto) which teaches the use of pre-defined rules in an iterative process for risk return asset valuation is being used to reject claims in co-pending U.S. Patent Application 10/097,344 for an invention that uses artificial intelligence methods to learn from the data and value elements of value without considering their risk. Of note is the fact that Sandretto was not cited during the review of almost all of the patents issued to a large company for inventions that use pre-defined rules in an iterative process for asset valuation and/or analysis.

2) the need to traverse apparent misrepresentations that one or more patents issued to a large company for an "invention" that does not appear to meet the requirements for patentability is relevant to an Asset Trust patent application.

3) the need to traverse rejections apparently made without explanation that inventions similar or identical to those found in patents issued to large companies represent non-statutory subject matter and/or lack utility.

4) the apparently improper use of Official Notice. For example, in application 10/237,021 Official Notice was claimed twice even though it was cited only once. No examples were provided that supported its use in either case and there was no response to the traversal of the Official Notice. This practice also appears to have been utilized in the instant application.

5) the need to traverse rejections apparently made without evidence that methods and/or claims similar or identical to those found in patents issued to large companies are "too subjective" and/or not enabled.

6) the need to traverse rejections made for informalities. This practice also appears to have been utilized in the instant application.

The subject matter contained in the discussion above may be deemed to relate to the present application, and thus may be felt (with or without reasonable justification) to be material to the prosecution of this instant application.

☐ Copies of cited U.S. patent application(s) (specification, claims, and the drawings) or copies of the portion(s) of the application(s) which caused it(them) to be cited,

including any claims directed to such portion(s) are attached hereto.

☒ Copies of the cited U.S. Patent Application(s) (specification, claims, and the drawings) and U.S. Patents are available on the U.S.P.T.O.'s Image File Wrapper. Therefore copies thereof need not be attached.

☐ The materials in the envelope are considered trade secrets and are being submitted for consideration under MPEP § 724.

The above-listed co-pending application(s) is not to be construed as prior art. By bringing the above-listed application(s) to the attention of the Examiner, the Assignee does NOT waive any confidentiality concerning the above-listed co-pending application(s) or this application. See MPEP §101. Furthermore, if said application(s) should not mature into patents, such application(s) should be preserved in secrecy under the provisions of 35 U.S.C. § 122 and 37 C.F.R. § 1.14.

Statement under 37 CFR 1.111

37 CFR 1.111 requires that the basis for amendments to the claims be pointed out after consideration of the references cited or the objections made. 37 CFR 1.111 states in part that:

> In amending in response to a rejection of claims in an application or patent undergoing reexamination, the applicant or patent owner must clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. He or she must also show how the amendments avoid such references or objections.

The Assignee notes that this requirement is not relevant to the instant application because, as detailed in prior communications, there are no references or objections to avoid. Having said that, the Assignee notes that the primary reasons the prior set of claims were amended to correct informalities to put the claims in final form for allowance and issue.

Request for Correction

In accordance with the relevant statutes and precedents the Assignee is entitled to expect and receive: an unbiased patent application examination conducted by an Examiner with knowledge of the relevant arts who follows the law. To date, the activity associated with the instant patent application bears no resemblance to the patent application examination standards dictated by statute and precedent. Among other things this has resulted in the allowance and issue of dozens of apparently invalid patents. Prompt correction is requested.

Reservation of rights

The Assignee hereby explicitly reserves the right to present the previously modified and/or canceled claims for re-examination in their original format. The cancellation or modification of pending claims to put the instant application in a final form for allowance and issue is not to be construed as a surrender of subject matters covered by the original claims before their cancellation or modification.

Conclusion

The pending claims are of a form and scope for allowance. Prompt notification thereof is respectfully requested.

Respectfully submitted,
Asset Trust, Inc.

/B.J. Bennett/

B.J. Bennett, President
Date: April 19, 2010